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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,492	03/12/2004	Harold K. Hilfiker	032687 08	5902

8685 7590 11/04/2009

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EXAMINER	
HARTMANN, GARY S	
ART UNIT	**PAPER NUMBER**
3671	

MAIL DATE	DELIVERY MODE
11/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/799,492	HILFIKER ET AL.	
	Examiner	Art Unit	
	Gary Hartmann	3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-19* is/are allowed.

6)☒ Claim(s) *20-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 251

Claims 20-22 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc.* v. *Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement,* 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997)*; Ball Corp.* v. *United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

On page 8 of applicant's response filed 28 June 2001 in parent application 09/568,338, with respect to claim 22 (which became claim 17 of parent patent 6,357,970), applicant argues the limitation of the support means being movable relative to the face. This relationship was included in the claim and important to the examination and patentability of the parent application. Because this relationship is missing from claims 20-22, it is an improper broadening of claimed subject matter. Also, see the recapture justification document, which is attached to the end of this action.

Allowable Subject Matter

Claims 1-19 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 571-272-6989. The examiner can normally be reached on Tuesday through Friday, 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gary Hartmann/
Primary Examiner, Art Unit 3671

The USPTO has recently informed the SPRE Shops throughout the Corps that the holdings regarding recapture, as provided for in the precedential decision by the Board of Appeals *Ex parte Eggert*, 67 USPQ2d 1716 (BPAI 2003), should no longer be controlling when a determination of whether or not recapture is present in any reissue application. Below is a legal analysis of how the Office is justifying the belief that case law mandates that a new test should be performed in deciding on whether or not recapture is present in a broadened reissue application. The following analysis may be incorporated into any Office action to serve as a basis for making a recapture rejection. However, until a test case is decided by the Board of Appeals, the analysis below can be used to justify the position on recapture that the Office is mandating in any Office action containing a recapture rejection.

The "recapture rule," prevents a patentee from regaining, through a reissue patent, subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

Clement discusses a three-step test for analyzing recapture:

Step *1* involves a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims.
Step 2 involves a determination of whether the broader aspects of the reissue application claims relate to surrendered subject matter.
Step 3 is applied when the broadening relates to surrendered subject matter and involves a determination whether the surrendered subject matter has crept into the reissue application claim.

Substep (3): if the reissue claim is broader in some aspects, but narrower in others, then:
(a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;
(b) if the reissue claim is narrower in an aspect

> germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

The Federal Circuit in *North American Container, Inc. v. Plastipak Packaging, Inc.,* 415 F.3d at 1350, 75 USPQ2d 1545 (Fed. Cir. 2005) further refined Substep (3)(a) of *Clement* to define "broader in an aspect germane to a prior art rejection" to mean broader with respect to a specific limitation

> (1) added to overcome prior art in prosecution of the application which matured into the patent sought to be reissued and
> (2) eliminated in the reissue application claims.

"Surrendered subject matter" is defined in connection with prosecution history estoppel in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,* , 535 U.S. 722, 733-34, 122 S. Ct. 1831, 1838, 62 USPQ2d 1705, 1710-11 (2002). A patentee's decision to narrow his claims through amendment "may be presumed to be a general disclaimer of the territory between the original claim and the amended claim." *Exhibit Supply,* 315 U.S., at 136-137, 62 S. Ct. 513. "…in determining whether 'surrender' of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's
amendment or argument was to overcome prior art and secure the patent." Kim v. ConAgra Foods, Inc., 465 F.3d 1312, 1323, 80 USPQ2d 1495, 1502 (Fed. Cir. 2006).

A further opinion, *Ex parte Eggert*, 67 USPQ2d 1716 (BPAI 2003), issued by the Board of Appeals and Interferences as a precedential opinion, is also part of the recapture precedent applicable to proceedings before the United States Patent & Trademark Office (USPTO). *Eggert* was entered on May 29, 2003, prior to the Federal Circuit's *North American Container* decision. In *Eggert* the majority held that the surrendered subject matter was the rejected claim **only** rather than the amended portion of the issued claim.

A published precedential opinion of the Board is binding unless the views expressed in an opinion in support of the decision, among a number of

things, are inconsistent with a decision of the Federal Circuit. In this case, the majority view in *Eggert* is believed to be inconsistent with the subsequent Federal Circuit decision in *North American Container* with respect to the principles governing application of Substep (3)(a) of *Clement*. See:
Ex parte Franklin C. Bradshaw and Thomas L. Soderman, (Appeal 2006-2744 Bd. Pat. App. & Int. July 19, 2007) (available in Application 09/664,794 and at http://www.uspto.gov/web/offices/dcom/bpai/its/fd062744.pdf);
Ex parte Raanan Liebermann, (Appeal 2007-0012 Bd. Pat. App. & Int. May 2007) (available in Application 09/603,247 and at http://www.uspto.gov/web/offices/dcom/bpai/its/fd070012.pdf);
Ex parte Willibald Kraus (Appeal 2005-0841 Bd. Pat. App. & Int. April 2005) (available in Application 08/230,083 and at http://www.uspto.gov/web/offices/dcom/bpai/its/fd050841.pdf)

As set forth in the above BPAI decisions, based on *North American Container* and other court decisions, surrendered subject matter is considered the subject matter of an application claim which was amended or canceled and, on a limitation-by-limitation basis, the territory falling between the scope of

(a) the application claim which was canceled or amended and
(b) the patent claim which was ultimately issued.

Accordingly, the "surrendered subject matter" that may not be recaptured through reissue should *be presumed* to include subject matter broader than the patent claims in a manner directly related to

(1) limitations added to the claims by amendment (either by amending an existing claim or canceling a claim and replacing it with a new claim with that limitation) to overcome a patentability rejection and
(2) limitations argued to overcome a patentability rejection without amendment of a claim.

However, when reissue claims are narrower than the patent claims with respect to features other than the surrender generating feature, then the reissue claims may be materially narrowed relative to the claims prosecuted and issued in the patent, thereby avoiding the recapture rule.

As explained in *Hester Industries, Inc, v Stein, Inc., 142 F.3d 1472,1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998)*, the recapture rule is avoided when two conditions are satisfied. First, an aspect of the invention must have been overlooked (e.g., not claimed) during patent prosecution. Second, the reissue claim must have been materially narrowed with respect to this overlooked aspect of the invention.

In summary, the recapture rule is avoided if the reissue claim was materially narrowed in other respects compared to its broadening surrendered aspect. A reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention:

(1) which had not been claimed and thus were overlooked during prosecution of the original patent application; and

(2) which patentably distinguish over the prior art.

Index of Claims

Application/Control No.	Applicant(s)/Patent under Reexamination
10/799,492	HILFIKER ET AL.
Examiner	**Art Unit**
Gary Hartmann	3671

√	Rejected	–	(Through numeral) Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

Claim		Date								
Final	Original	10/16/09								
	1	=								
	2	=								
	3	=								
	4	=								
	5	=								
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	8	=								
	9	=								
	10	=								
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	17	=								
	18	=								
	19	=								
	20	√								
	21	√								
	22	√								

Claim		Date								
Final	Original									

Claim		Date								
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